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Patents Department
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EXAMINER

HARPER, KEVIN C

ART UNIT

PAPER NUMBER

2666

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/665,743

Applicant(s)

ROSEN ET AL.

Examiner

Kevin C. Harper

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7, 18-21, 23, 25-28 and 31-34 is/are rejected.
- 7) ☒ Claim(s) 5, 8-17, 22, 24, 29, 30 and 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5-6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Drawings

1. The corrected or substitute drawings were received on October 24, 2000. These drawings are disapproved (see drawing objections below).
2. Figure 3 is objected to because item 12 requires descriptive wording (37 CFR 1.83(a)).
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 318, found on page 12, line 11.
4. Figure 5 is objected to because it should be designated by a legend such as --Prior Art-- because only that which is old is illustrated (specification, page 13, lines 24-30). See MPEP § 608.02(g).

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities: on page 1, line 18, "in" should be removed. Appropriate correction is required.
6. The disclosure is objected to because it contains embedded hyperlinks and/or other forms of browser-executable code on page 2. Applicant is required to delete the embedded hyperlinks and/or other forms of browser-executable code. See MPEP § 608.01.

Claim Objections

7. Claims 9-14 are objected to because in claim 9, at lines 21-22, "said storage device for storing said information needed to construct datagrams at said receiving station" should be removed because this limitation is present at lines 17-18.

8. Claim 14 is objected to because "said destination device" should be --a device across said data network-- and because "destination communication device" in lines 4-5 and 11 should be --second communication device--.

9. Claim 15 is objected to because it should depend upon claim 14 and not claim 5, because "the destination communication device" in line 1 should be -- the second communication device--, and because "data packets from said destination device" in line 3 should be --datagrams from said device--.

10. Claim 16 is objected to because it should depend upon any of claims 9-14 and not claim 5.

11. Claim 17 is objected to it should depend upon claim 16 and because at line 2, "said destination communication device" should be -- said second communication device--.

12. Claims 25-30 are objected to because in claim 25, at line 8, "across a data network" should be removed.

13. Claims 31-35 are objected to because in claim 31, at lines 10 and 11, "data packets" should be --datagrams-- and, at lines 12-13, "said at least one data network protocol" should be --said datagrams each--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 18-21, 25-28 and 31-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Kimball (US 5,953,322).

14. Regarding claims 1 and 18, Kimball discloses an apparatus (or method) for reducing transmission overhead in a communications system (Figure 1, item 10 or 34; Figure 4; col. 2, lines 21-22; col. 3, lines 51-59). The apparatus comprises a processor (Figure 4, item 50; col. 6, lines 55-60) for generating a data origination message (col. 3, lines 60-63; col. 4, lines 5-11 and lines 25-28; col. 5, lines 58-67) which initiates a data communication with a receiving station (Figure 1, item 30 or 32). The processor further transmits information needed to construct data network header information at the receiving station (Figure 2A, item 118; col. 9, lines 5-12 and 14-17) and for subsequently formatting information to be transmitted in accordance with a predetermined format which lacks data network header information (Figure 2C; col. 3, lines 51-59). The apparatus further comprises a transmitter (Figure 4, item 58) for transmitting the data origination message and the formatted information to the receiving station.

15. Regarding claim 25, the method further comprises receiving information needed to construct datagrams at the receiving station by the receiving station (col. 3, lines 60-63; col. 4, lines 5-11 and lines 25-28; col. 9, lines 5-12 and 14-17), storing the information in a storage device (Figure 8, item 78), and inherently configuring a data packet generator (Figure 8, items 72 and 76) to generate

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datagrams in accordance with the information (note: the processor and Internet communication subsystem are (or have been) configured create and transmit IP packets). Each datagram includes a network header which uses the destination network address in the storage device (col. 9, lines 14-17). The method further comprises receiving formatted information from the communications device (col. 3, lines 51-59) and sending the datagrams across the data network (Figure 1, item 100; col. 9, lines 5-9) to a destination data network address.

16. Regarding claim 31, Kimball discloses a method for reducing transmission overhead in a communications system (Figure 1, item 10 or 34; Figure 4; col. 2, lines 21-22; col. 3, lines 51-59). The method comprises receiving a data origination message from a communication device (col. 3, lines 60-63; col. 4, lines 5-11 and lines 25-28; col. 5, lines 58-67) which initiates a data communication with a receiving station (Figure 1, item 30 or 32). The method further comprises receiving information needed to construct datagrams at the receiving station by the receiving station (col. 3, lines 60-63; col. 4, lines 5-11 and lines 25-28; col. 9, lines 5-12 and 14-17), storing the information in a storage device (Figure 8, item 78), and inherently configuring a data packet generator (Figure 8, items 72 and 76; note: the processor and Internet communication subsystem are (or have been) configured create and transmit IP packets) to generate and transmit datagrams across a data network (Figure 1, item 100; col. 9, lines 5-9) to a destination device (Figure 1, item 210). The datagrams are formatted in accordance with IP (Figure 8, item 72; col. 9, lines 5-9) and each datagram has an IP header (col. 9, lines 9-12) formed from destination network address in the storage device (col. 9, lines 14-17). The method further comprises receiving formatted information (col. 3, lines 51-59) from the communication device, constructing datagrams in accordance with the

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data packet generator configuration, and sending the datagrams across the data network (Figure 1, item 100; col. 9, lines 5-9) to a destination device (Figure 1, item 210).

17. Regarding claims 2-4, 19-21, 26-28 and 32-34, the data origination message comprises information needed to construct data network header information (col. 7, lines 36-43; col. 9, lines 14-17). The information is a destination IP address (col. 7, lines 36-43; col. 6, lines 1-4) which is one field of a standardized IP header.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 6 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimball (US 5,953,322).

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18. Regarding claims 6 and 23, Kimball does not disclose that formatted information is not transmitted until an acknowledgement is received from the receiving station. Examiner takes Official Notice that, preferably, communication does not take place in a communication system until a request for communication has been acknowledged. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to delay transmitting formatted information until an acknowledgement is received in the invention of Kimball in order to avoid transmission when the communications request was not received properly or was denied, or in order to ensure that communications appropriate resources are available before continuing with subsequent transmissions.

Allowable Subject Matter

19. Claims 5, 7, 8, 22, 24, 29-30 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

20. Claims 9-17, 29-30 and 35 would be allowable if rewritten to overcome the above claim objections.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Barany et al. (US 2002/0064164; abstract, lines 9-18) and Le (US 6,466,585; Figure 6) each discloses removing data network headers over a wireless communication link. Tran et al. (US

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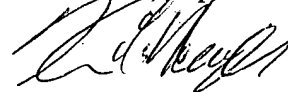
2002/0001315) discloses compressing an IP header to conserve bandwidth over a communication link (abstract).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Harper whose telephone number is 703-305-0139. The examiner can normally be reached weekdays, except Wednesday, from 9:30 AM to 8:00 PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao, can be reached at 703-308-5463. The fax number for Technology Center (TC) 2600 is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service Office for TC 2600 at 703-306-0377.

Kevin C. Harper



June 24, 2003